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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re S. Martinelli & Company

Serial No. 76/092,345

Ian K. Boyd of Harvey Siskind Jacobs LLP for S. Martinelli & Company.

Wanda Kay Price, Trademark Examining Attorney, Law Office
111 (Kevin Peska, Acting Managing Attorney).

Before Simms, Cissel and Hairston, Administrative Trademark
Judges.

Opinion by Hairston, Administrative Trademark Judge:

S. Martinelli & Company has filed a trademark
application to register the mark shown below,

Martinelli's
GOLD MEDAL

for "mulling spice."¹

The Trademark Examining Attorney² has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark, when applied to its goods, so resembles each of the following marks, which are registered to the same entity, as to be likely to cause confusion:

GOLD MEDAL (typed letters); and

Gold Medal

both for "spices and processed herbs; and extracts other than vanilla, used as a food flavoring and food flavoring, other than vanilla, containing nonessential oils, and mustard."³

¹ Serial No. 76/092,345, filed July 7, 2000, alleging first use and use in commerce as of August 26, 1998.

² The present Examining Attorney was not the original Examining Attorney in this case.

³ Registration No. 1,848,669 issued August 9, 1994; and Registration No. 1,891,248 issued April 25, 1995; respectively. Affidavits under Sections 8 & 15 accepted and acknowledged, respectively in both registrations.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The Examining Attorney argues that applicant's mark merely incorporates registrant's mark in its entirety and adds to it applicant's "house mark" which does not distinguish the marks. Further, she argues that the third-party registrations of GOLD MEDAL marks submitted by applicant are not evidence of use of the marks therein and that the registrations cover goods that are different from the goods involved herein.

In addition, the Examining Attorney contends that applicant's "mulling spice" and registrant's "spices" are

legally identical goods that are sold in the same channels of trade to the same class of purchasers.

Applicant, in urging reversal of the refusal to register, argues that its goods are used solely in connection with mulled cider and do not compete with registrant's goods. In addition, applicant argues that it is well known in the industry and applicant submitted a copy of its Internet home page that states that applicant started in the apple cider business in 1868.

With respect to the marks, applicant argues that marks consisting of or containing the term "gold medal" are weak marks that are therefore entitled to only a limited scope of protection. It is applicant's position that the term GOLD MEDAL is highly laudatory and has been used so frequently in marks that no one party may claim exclusive rights to GOLD MEDAL. In support of its claim that GOLD MEDAL marks are not uncommon, applicant included in its brief a list of nine third-party registrations for GOLD MEDAL marks that cover various foods and beverages.⁴

⁴ Normally, a mere list of third-party registrations would be insufficient to make such registrations properly of record. Also, evidence submitted for the first time with a brief on appeal is normally considered by the Board to be untimely and therefore would usually be given no consideration. However, where, as here, the Examining Attorney has not only failed to object to the evidence, but has discussed it in her brief, the Board will treat the evidence as being of record. See *In re Nuclear Research Corp.*, 16 USPQ2d 1316, 1317 (TTAB 1990) at n. 2.

Considering first the goods involved in this case, we note that the question of likelihood of confusion must be determined based on an analysis of the goods identified in applicant's application vis-à-vis the goods identified in the cited registrations. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). Although applicant argues that its goods do not compete with registrant's goods, the cited registrations set forth "spices" with no limitations or restrictions, and these would include "mulling spice." Thus, for purposes of our likelihood of confusion analysis, the goods of applicant and registrant are, in part, legally identical.

We turn then to a determination of whether applicant's mark and the registered marks, when viewed in their entirety, are similar in terms of appearance, sound, connotation and commercial impression. Although the marks at issue must be considered in their entirety, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Clearly, registrant's marks and the GOLD MEDAL portion of applicant's mark are virtually identical. In this

regard, we note the third-party registrations relied on by applicant that show that GOLD MEDAL has been adopted by entities in the food and beverage industries and that it has less than arbitrary significance in these fields.

Further, we judicially notice that "gold medal" is defined in the DK Oxford Illustrated Dictionary (1998) at 350 as: "a medal of gold, usu. awarded as first prize"; and "gold" is defined in Webster's Universal Dictionary (2002) at 789, no. 5 as: a medal awarded as the top prize in a competition: a gold medal."

In view of the foregoing, it is likely that purchasers will consider the term GOLD MEDAL in a trademark to be laudatory in nature and, thus, highly suggestive of the quality of the goods so identified. Thus, it is MARTINELLI'S that is likely to be perceived as the dominant portion of applicant's mark, especially since it is the first word in the mark and it is displayed in larger and bolder print than GOLD MEDAL. In this case, because of the highly suggestive nature of the term GOLD MEDAL and the fact that it is displayed in a subordinate manner, the impression created by applicant's mark is that MARTINELLI'S is the source-identifying portion of the mark, which is followed by a term that is highly suggestive of the quality of the goods.

As stated by the Board in the case of In re Christian Dior, S.A., 225 USPQ 533, 534 (TTAB 1985):

Where there are some recognizable differences in the asserted conflicting product marks or the product marks in question are highly suggestive or merely descriptive or play upon commonly used or registered terms, the addition of a house mark and/or other material to the assertedly conflicting product mark has been determined sufficient to render the marks as a whole sufficiently distinguishable. (citations omitted.)

In sum, when we compare the respective marks in their entireties, and giving appropriate weight to MARTINELLI'S in applicant's mark, we find that the marks are dissimilar in sound and appearance. Also, applicant's mark has the connotation of a surname and superior products whereas registrant's marks have just the laudatory connotation.

Under these circumstances, we find the addition of MARTINELLI'S to the highly suggestive term GOLD MEDAL to sufficiently distinguish applicant's mark from registrant's marks, notwithstanding that the goods are, in part, legally identical. We conclude therefore that confusion as to the source or sponsorship of the involved goods is not likely.

Decision: The refusal to register under Section 2(d) in view of Registration Nos. 1,848,669 and 1,891,248 is reversed.